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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/598,042 06/20/00 TANG

Y 784CIP2

EXAMINER

HM12/0416

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HYSEQ INC
670 ALMANOR AVENUE
SUNNYVALE CA 94086

ART UNIT	PAPER NUMBER
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1631
DATE MAILED:

04/16/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/598,042	Applicant(s) TANG ET AL.	
	Examiner Stephen Siu	Art Unit 1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-28 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- | | |
|---|--|
| 15) <input type="checkbox"/> Notice of References Cited (PTO-892) | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____ |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 20) <input type="checkbox"/> Other: |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

1. Claims 1-9, and 19 drawn to polynucleotides, vectors, host cells, and method of producing a polypeptide, classified in class 536, subclass 23.1.
2. Claims 10-11, 20-21, drawn to polypeptides, classified in class 530, subclass 300.
3. Claim 12, drawn to an antibody, classified in class 424, subclass 130.1.
4. Claims 16, drawn to a method for detecting a polypeptide, classified in class 424, subclass 130.1.
5. Claims 17-18, drawn to methods for identifying a compound that binds to a polypeptide, classified in class 702, subclass 19.
6. Claims 22-26, drawn to a collection or array of polynucleotides, classified in class 702, subclass 20.
7. Claim 27, drawn to a method of treatment comprising administering a polypeptide, classified in class 435, subclass 6.
8. Claim 28, drawn to a method of treatment comprising administering an antibody, classified in class 435, subclass 6.
9. Claim 13, drawn to a method of detecting a polynucleotide, classified in class 435, subclass 5.

10. Claims 14 and 15, drawn to a method for detecting a polynucleotide involving amplifying a product of the polynucleotide, classified in class 435, subclass 5.

The inventions are distinct, each from the other because of the following reasons:

Inventions 1, 2, 3, and 6 are unrelated. Invention 1 is unrelated to Inventions 4, 5, 7 and 8. Invention 2 is unrelated to Invention 8. Invention 6 is unrelated to Inventions 4, 5, 7 and 8. Invention 2 is unrelated to Invention 8. Invention 3 is unrelated to Invention 7. Inventions 2-8 are unrelated to Inventions 9-10. Invention 9 is unrelated to Invention 10. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions, structures and effects.

Invention 1 is related to Inventions 9 and 10 as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polynucleotide can be used in a materially different process such as producing a protein.

Invention 2 is related to Inventions 4, 5 and 7 as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another

materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polypeptides can be use in materially different processes such as in a method of detection of the polypeptide, or in a method of identifying compounds that bind to the polypeptide or in a therapeutic method of administering the polypeptide.

Invention 3 is related to Inventions 4, 5 and 8 are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the antibody can be used in materially different processs such as in a method of detection of polypeptides, or in a method of identifying compounds that bind to polypeptides or in a therapeutic method of administering an antibody.

Invention 6 is drawn to a collection of polynucleotides comprising at least one sequence recited in SEQ ID NOS. The claims recite different combinations of individual nucleotide sequences and is subject to a further restriction requirement. If Invention 1 is selected, Applicants are required to select one combination of polynucleotides for examination (see MPEP 803.04).

In addition, Groups 2-8 detailed above reads on patentably distinct complex sequences. Each sequence is patentably distinct because they are unrelated sequences, and a further restriction is applied to each Group. For an elected Group, the Applicants must further elect a single sequence.

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Examination will be restricted to only the elected sequences.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

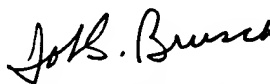
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen C Siu whose telephone number is 703-308-7522. The examiner can normally be reached on M-F, 7:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, M Woodward can be reached on 703-308-4028. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-0294 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Stephen Siu




JOHN S. BRUSCA, PH.D
PRIMARY EXAMINER